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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,211	02/22/2002	Yeok Sing Sio	KL0433US (#90232)	1353

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CLEVELAND, OH 44114

EXAMINER

ESTREMSKY, GARY WAYNE

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 12/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/069,211

Applicant(s)
Sio

Examiner
Estremsky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on amdt filed 10/31/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Opening Remarks

1. Inasmuch as there may have been some misunderstanding whether a 'replacement' Office Action would be mailed, it was agreed previous to filing of the Amendment after Final (Paper No. 9) that such amendment would be entered to provide Applicant further opportunity to respond to the grounds of rejection raised in the First Office Action. Accordingly, the amendment after Final has been entered. Inasmuch as that amendment necessitates changes in grounds of rejection, Finality of the previous Office Action has been withdrawn to allow full consideration of that amendment.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim defines the invention as part of a step in a method of use, i.e., "deformed as the first and second members are moved". The claim is indefinite since it appears to be for a *product*

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and *process of using* the product in the same claim whereby it is not clear how to interpret the claim. See MPEP 2173.05(p) sections I, II.

If prosecution is Continued - to claim only the product, it is suggested that defining the structure's 'capability' to be deformed is one approach. Another approach might be to simply define the structure's (deformed) geometry in such a way as to patentably define from the geometry of the structure of the reference. Alternatively, a claim for a *process of using*, including a step of deforming could be added although that might necessitate a requirement for restriction (depending on form and content of such claims) between *product* and *process of using*.

4. Claims 4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear if there is, or should be a "-2" in the units portion of the Young's modulus in the claims. Clarification and/or correction to correspond with the materials disclosed is requested.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 1-3, 6, and 8-21 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 2,914,936 to Reinhold.

Reinhold '936 teaches Applicant's claim limitations including : "first" - including 14, and "second catch member" - including 15. The catch members of the reference are disclosed to be made of plastic where due to their geometry, they are inherently flexible.

Examiner notes that limitation of "said first and second catch members being located in the narrow space between the first and second members" positively recites and implicitly includes the "first" and "second members" as part of the claimed invention. Reinhold '936 teaches "first member and second members" - 10,10. Parts 22 are located on "shafts" (14,15) in a space between the first and second members as shown on the face of the patent.

As regards claim 2, assuming the limitation is intended to define a capability of the claimed product if used in a certain way, it is the examiner's position that both of the catch members are *capable* of permanent deformation as a result of inappropriate forceful opening, etc due to inherent characteristics of the material from which they are made. It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Similarly, with respect to claim 9, the structure of the reference is inherently capable of flexing large angular amounts whether or not it is disclosed as part of normal operation. Again,

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‘capable of,...’ recitations are generally broad limitations since no particular structure is actually specified.

As regards claim 3, one of ordinary skill in the art would recognize that pulling parts 10/10 apart would inherently result in broadly-recited function.

As regards claim 10, Fig 3 of the reference illustrates the overall “L” shape.

As regards claim 12, as determined from Fig 1, each panel 10, “has at least two catch members”.

As regards claim 13, with one catch member on either of two parallel panel sides, limitation of “at least two catch members are arranged along a whole length of at least one of the first and second panels” does not patentably define from the structure of the reference.

As regards claim 14, catch members on either parallel or perpendicular edges read on broad limitation.

As regards claim 15, catch members on opposite and parallel panel edges read on broad limitation of “the first orientation is substantially opposite to the second orientation”.

As regards claim 16, the two horizontal and the two vertical catch members of a panel 10 read on limitation.

As regards claim 17, the screw in combination with part 11 read on limitation of “lock member” where no further structure is defined. Tightening the screw (from a loosened position) would inherently move the first and second member whereby the broadly-recited function is inherent to the ‘configuration’ disclosed by the reference.

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As regards claim 20, prior to attachment of screw, the panels 10 are inherently capable of being relatively slid where the claim is most reasonably interpreted as broadly defining a *capability* and not as a *product* and *process of using* in the same claim.

7. Claims 1-3, 6, 8-10, 12-16, and 20-24 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 5,647,618 to Lamberth.

Lamberth '618 teaches Applicant's claim limitations including : "first and second members" - 14,16 as shown in Fig 3,4, "first and second catch members" - including 34,84 as shown in Fig. 3 whereby the interengaged hooked ends read on "projection portion" and the horizontal (as shown in Fig 3) adjacent thereto reads on "shaft portion".

Balance of functional limitation describing how the projections can be flexed towards each other if pried does not patentably define over the structure of the prior art which is inherently capable of being pried such that the projections are flexed as claimed. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). The law of anticipation requires that a distinction be made between the invention described or taught and the invention claimed. It does not require that the reference "teach" what the subject patent teaches. Assuming that a reference is properly "prior art," it is only necessary that the claims under consideration "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the

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reference, or "fully met" by it. *Kalman v. Kimberly-Clark Corp.*, 218 USPQ 789. Claims in a pending application should be given their broadest reasonable interpretation. In re Pearson, 181 USPQ 641 (CCPA 1974).

8. Claims 1-4, 6-12, 14, 15, 20, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 3,050,322 to Miller.

Miller '322 teaches Applicant's claim limitations including : "first and second members" - 4,B as shown on the face of the patent, "first and second catch members" - including 9,14 3 whereby the interengaged hooked ends read on "projection portion" and the adjacent portion reads on "shaft portion".

As regards claim 2, the structure of the reference is inherently capable of being permanently deformed as the members are forcibly pried apart.

As regards claim 3, the shafts of the catch members are inherently capable of being flexed apart if the members are forced towards the open position. Part 14 is provided with spring and pivot structure that would inherently allow for such flexure while part 9 is explicitly disclosed to be made of any of several materials including plastic whereby it would inherently flex as claimed given sufficient opening force being applied.

As regards claims 4 and 5, Miler explicitly discloses that part 9 may be aluminum at col 3, line 68-70 (even though plastic is preferred). Aluminum inherently has Young's approximately 70 GNm² but to the examiner's knowledge never as high as 103 GNm² (claim 5)

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Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 2,914,936 to Reinhold.

As regards claim 2, although the reference does not disclose unauthorized tampering and excessive prying, one of ordinary skill in the art would recognize that, much like the present invention, the structure of the reference is inherently capable of being permanently deformed during improper use, especially by excessive prying forces etc. Like the present invention, such misuse will inherently permanently deform the device and may ultimately cause it to fail etc.. One of ordinary skill in the art would recognize that certain excessive prying, etc. to remove the panels would result in permanent deformation of the catch members. It is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to distinguish over the prior art. Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the

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prior art does not possess the characteristic relied on. In re Swinehart, 169 USPQ 226 (CCPA1971).

As regards claim 7, although Reinhold '936 does not explicitly disclose any of the claimed materials, it would have been an obvious design choice for one of ordinary skill in the art at the time of the invention to form from UPVC since that material is equivalent (as regards function of the device) to the plastic explicitly disclosed. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. In this case, manufacture from UPVC would not otherwise affect function of the disclosed device whereby one of ordinary skill in the art would have more than a reasonable expectation of success.

11. Claims 2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,647,618 to Lamberth.

As regards claim 2, although the reference does not disclose unauthorized tampering and excessive prying, one of ordinary skill in the art would recognize that, much like the present invention, the structure of the reference is inherently capable of being permanently deformed during improper use, especially by excessive prying forces etc. Like the present invention, such misuse will inherently permanently deform the device and may ultimately cause it to fail etc.. One of ordinary skill in the art would recognize that certain excessive prying, etc. to remove the panels would result in permanent deformation of the catch members.

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As regards claim 7, although Lambert '618 does not explicitly disclose any of the claimed materials, it would have been an obvious design choice for one of ordinary skill in the art at the time of the invention to form from UPVC since that material is equivalent (as regards function of the device) to the plastic explicitly disclosed. In this case, manufacture from UPVC would not otherwise affect function of the disclosed device whereby one of ordinary skill in the art would have more than a reasonable expectation of success.

12. Claims 2, 5, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 3,050,322 to Miller.

As regards claim 2, although the reference does not disclose unauthorized tampering and excessive prying, one of ordinary skill in the art would recognize that, much like the present invention, the structure of the reference is inherently capable of being permanently deformed during improper use, especially by excessive prying forces etc. Like the present invention, such misuse will inherently permanently deform the device and may ultimately cause it to fail etc.. One of ordinary skill in the art would recognize that certain excessive prying, etc. to remove the panels would result in permanent deformation of the catch members.

As regards claim 5, although Miller '322 does not explicitly disclose a material having the specified Young's modulus, it would have been an obvious engineering expedient or design choice for one of ordinary skill in the art at the time of the invention to form the catch members from steel (which inherently has Young's modulus meeting terms of the claim) in order to increase

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the strength of the latch. In this case, manufacture from steel would not otherwise affect function of the disclosed device whereby one of ordinary skill in the art would have more than a reasonable expectation of success.

13. Claims 1, 2, 3, 6-15, 17-20, and 22 are rejected under 35 U.S.C. 103) as being unpatentable over U.S. Pat. No. 5,641,186 to Ross.

Ross '186 teaches Applicant's claim limitations including : "first and "second catch members" - including 60,60 having structure which reads on the claim limitations. Ross '186 illustrates "first and second members" (24,24') on the face of the patent where the "catch members" are located in the relatively narrow space therebetween. Ross '186 illustrates the "shaft" portions (nearest parts 24,24') of each catch member to be substantially collinear in Fig 3. However, one of ordinary skill in the art would have found it obvious at the time of the invention to use the catch members on first and second members that are a little bit out of alignment whereby the shafts would inherently be "parallel" as now claimed. One of ordinary skill in the art would have more than a reasonable expectation of success since the device is inherently tolerant of relatively large misalignments in the members.

As regards claims 2 and 9, as above, *capable* limitations are generally broad since no particular structure is actually defined.

As regards claim 10, the attachment portion of each member 60 defines a rather box-like base for the "L" shape.

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Response to Arguments

14. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Argument that a prior art reference is intended to be used in a manner different from the disclosed invention, or is not intended to solve the same problem as the *disclosed invention* are not persuasive where it is the *claimed invention* that must be examined.

While a functional limitation can sometimes be used to further define a structure, ultimately it is the structure of a claimed *product* that must be relied upon to patentably define from the prior art. Case law and consequently, the MPEP are clear in this regard (See MPEP 2114). The examiner has carefully reviewed the functional language of present claims and has found no structure clearly defined in the claims (either explicitly or implicitly) in such a way as to patentably define from the structure of the prior art as applied. Persuasive argument to the contrary should point out specific structure defined in the claim that is not taught by the prior art.

It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

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The law of anticipation requires that a distinction be made between the invention described or taught and the invention claimed. It does not require that the reference "teach" what the subject patent teaches. Assuming that a reference is properly "prior art," it is only necessary that the claims under consideration "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "fully met" by it. *Kalman v. Kimberly-Clark Corp.*, 218 USPQ 789.

Claims in a pending application should be given their broadest reasonable interpretation. In re Pearson, 181 USPQ 641 (CCPA 1974).

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. U.S. Pat. No. 3,050,322 to Miller.
- b. U.S. Pat. No. 3,822,905 to Bell.
- c. U.S. Pat. No. 4,216,984 to Hofmann.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Submission of any response by facsimile transmission is encouraged. Group 3677's relevant facsimile number is :

(703) 872-9306 - for all formal communications to be entered into the Application.

Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly within our examining group and will eliminate Post Office processing and delivery time and will bypass the PTO's mail room processing and delivery time. For a complete list of correspondence **not** permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a Deposit Account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitted by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) ____ - ____) on _____
(Date)

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Typed or printed name of person signing this certificate:

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Estremsky whose telephone number is (703) 308 - 0494. The examiner can normally be reached on M - Th from 730 am to 600 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann, can be reached on (703) 306-4115.

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19. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

- Technology Center 3600 Customer Service is available at 703-308-1113.

- General Customer Service numbers are at 800-786-9199 or 703-308-9000.

GWE

December 1, 2003

A handwritten signature in black ink, appearing to read 'GWE', with a stylized, cursive script.

**GARY ESTREMSKY
PRIMARY EXAMINER**